UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/616,738	DREW ET AL.
	Examiner	Art Unit
	HEIDI RIVIERE	3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>5/17/2010</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,4-20 and 22-46</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-2, 4-20, 22-46</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission n filed on **17

May 2010** has been entered.

RESPONSE TO ARGUMENTS

2.   Applicant's arguments with respect to **Claims 1-2, 4-20, 22-46** have been

considered and the rejection has been revised. The above claims remain rejected.

Examiner used **Spencer (US 6,356,909 B1)** patent and **Spencer** in view of

Vanderboom et al. (US 2002/0147596 A1) (hereinafter "**Vanderboom**") to reject claims

1-2, 4-20, 22-46. Spencer teaches a web based system for managing request for

proposals and responses while Vanderboom disclose an online laboratory services

brokerage system.

        With respect to rejections under 35 USC 103, the analysis should be whether

one in the art at the time of the invention would find it obvious to combine the two

references. Applicant does not review the references in combination but instead

presents each separately. Applicant argues that tallying is not the same as matching.

However, the Spencer reference does teach matching. In column 14, lines 25-67

Spencer teaches "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question". And Fig. 24 teaches how the response history matches a given question. furthermore teaches project questionnaires. A survey is essentially a compilation of questions. The Spencer reference compiles questions to be used in requests for proposals. The Vanderboom reference teaches that the requests can be environmental. As a result, the rejection provided is adequate.

Applicant argues that the references sited do not teach transferring modified data to a central station. However, "modified" seems to be a label placed on the data because there is not information presented in the claimed limitation showing that the system is adept to modify data. As such, "modified" is merely type of data transferred.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   **Claims 1-2, 4-20, 22-46** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims

to include the term "predefined" however the specification does not include this term.

There is also no allusion to predefinition of survey criteria.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 42-43 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant

extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because claims 42 and 43 do teach method steps tied to a machine or apparatus. In claim 42 teaches that all the pertinent steps are performed prior to the user transmitting the data to the central station. The steps mentioned do not have a tie to a machine or apparatus, However it appears that the steps of translating the input and selecting the criteria while material to the invention are performed manually. As a result, the step of transmitting the survey to the central station is directed to insignificant extra solution activities and is insufficient to render the otherwise ineligible process claim as statutory.

Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   **Claims 1-2, 4-20, 22-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Spencer (US 6,356,909 B1)** in view of **Vanderboom et al. (US 2002/0147596 A1)** (hereinafter "**Vanderboom**").

8.   **With respect to claim 1: (Currently amended)** Spencer teaches:

- environmental project survey storage means for storing data representative of at least one project survey; (col. 4, lines 27-30; col. 8, lines 38-43 – RFP questions are stored in the response database)

- display means, responsive to a user selecting an project survey, for presenting said user with a display of <u>sections of</u> environmental project survey, said environmental project survey including a plurality of <u>predefined</u> criteria data categories; (col. 3, lines 18-67 – question database; "an automated response system enables RFP respondents to capitalize on their previously created responses"; users respond to questions; "computer system assembles and organizes the information into a common format...accessible through a website interface"; "the system helps users track critical proposal guidelines)

- input means for enabling said user to input data into at least one of said plurality of <u>predefined</u> criteria data categories on said <u>selected</u> project survey, (col. 3, lines 18-67 - computer used to organize and make information accessible)

- data transfer means for transmitting said project survey <u>and said user modified predefined criteria data categories</u> to a central station; (col. 3, lines 18-67 – web interface used to make information accessible over the Internet)

- database means located in said central station for storing said project survey <u>and said user modified predefined criteria data categories as well as</u> data representative of at least one characteristic of each of said resource providers; (col. 4, lines 27-30; col. 8, lines 38-43 - RFP questions are stored in the response database) and

- survey query means operable with said database means for automatically matching said user input data from said <u>selected</u> project surveys with said data representative of said at least one characteristic of each of said resource providers <u>to select</u> one of said projects for funding by at least one of said resource providers. (Fig. 24; col. 14, lines 56-67 – "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question")

Spencer does not teach, however Vanderboom teaches environmental information and the following:

- said <u>selected</u> environmental project survey having hierarchically organized tiers of <u>predefined</u> criteria data categories selected from the group consisting of air, energy, land, waste, and water, such that when one of the <u>predefined</u> criteria data categories are selected by said user, subcategories relating to said selected criteria data categories are displayed to said user; (page 3,

paragraph 43 – see chart, categories separated into tier 1, tier 2, and tier 3; categories include petroleum, forest/paper and agriculture; Fig. 9_2 – list member laboratory capabilities in the areas of environmental soil, waste, hazardous waste and water analysis that could be helpful in various projects especially pollution prevention)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

Furthermore, the data identifying categories of projects is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,*

703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time whether they should submit a proposal.

The Examiner asserts that the data identifying categories of projects adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is

non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

9.   **With respect to claim 2:** Spencer teaches the limitations cited in the above rejections.   Spencer fails however Vanderboom discloses identified environmental projects is selected from the group of projects consisting of clean energy projects, energy efficient projects, and pollution prevention projects.   (Fig. 9_2 – list member laboratory capabilities in the areas of environmental soil, waste, hazardous waste and water analysis that could be helpful in various projects especially pollution prevention)

        As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time whether they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories.   Both disclosures compliment each other because both deal with proposals and therefore the combination

of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

10.   **With respect to claim 4: (previously presented)** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses said tiers are selected from a group consisting of a first tier, a second tier and a third tier. (page 3, paragraph 43 – see chart, categories separated into tier 1, tier 2, and tier 3)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific tiers of the groups because this would enable laboratories to know ahead of time whether they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories.   Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

11.   **With respect to claim 5: (currently amended)** Spencer teaches the limitations

cited in the above rejections. Spencer fails however Vanderboom discloses first tier

comprises <u>predefined</u> criteria data categories selected from the group consisting of air,

energy, land, waste, and water. (page 3, paragraph 43 – see chart, categories

separated into tier 1, tier 2, and tier 3; first tier includes petroleum)

As a result, it would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the teaching of Spencer with details of Vanderboom

regarding the specific tiers of the groups because this would enable laboratories to

know ahead of time whether they should submit a proposal. As a result, it would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the

system in Spencer with the Vanderboom invention in regards to finding a laboratory

capable of performing the request in the proposal. The Spencer system is web based

and manages the requests for proposals and responses. The Spencer system provides

the structure necessary to create the RFP, analyze responses and find an appropriate

match. The system Vanderboom presents an online laboratory services brokerage

system used to select laboratories capable of working on specific projects the match

their capabilities using a tier system for organizing categories.   Both disclosures

compliment each other because both deal with proposals and therefore the combination

of both would be obvious because their ultimate goal is finding a laboratory to perform

the requested task.

12.   **With respect to claim 6: (currently amended)** Spencer teaches the limitations

cited in the above rejections. Spencer fails however Vanderboom discloses selected

first tier displays a second tier of related <u>predefined</u> criteria data categories. (page 3, paragraph 43 – see chart, categories separated into tier 1, tier 2, and tier 3)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific tiers of the groups because this would enable laboratories to know ahead of time whether they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

13.   **With respect to claim 7: (currently amended)** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses selected air first tier displays a second tier of <u>predefined</u> criteria data categories selected from the group consisting of acid precipitation, ambient, indoor, monitoring, noise, odor, pollutants/criteria, pollutants/gases, pollutants/greenhouse, pollutants/particulate matter,

pollutants/primary/secondary,   radon,   sampling,   sources/area,   sources/fugitive,
sources/mobile commercial, sources/mobile fleet, sources/mobile passenger, sources
stationary, visibility/pristine, and visibility/urban. (fig. 8_4 – halogens; page 3, paragraph
43 – see chart, categories separated into tier 1, tier 2, and tier 3; first tier includes a
category for chemical)

As a result, it would have been obvious to one of ordinary skill in the art at the
time of the invention to modify the teaching of Spencer with details of Vanderboom
regarding the specific projects because this would enable laboratories to know ahead of
time why they should submit a proposal. As a result, it would have been obvious to one
of ordinary skill in the art at the time of the invention to modify the system in Spencer
with the Vanderboom invention in regards to finding a laboratory capable of performing
the request in the proposal. The Spencer system is web based and manages the
requests for proposals and responses. The Spencer system provides the structure
necessary to create the RFP, analyze responses and find an appropriate match. The
system Vanderboom presents an online laboratory services brokerage system used to
select laboratories capable of working on specific projects the match their capabilities
using a tier system for organizing categories. Both disclosures compliment each other
because both deal with proposals and therefore the combination of both would be
obvious because their ultimate goal is finding a laboratory to perform the requested
task.

Furthermore, the data identifying types of categories is non-functional descriptive
data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying types of categories adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is

non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

14.   **With respect to claim 8: (currently amended)** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses selected energy first tier displays a second tier of <u>predefined</u> criteria data categories selected from the group consisting of biofuels, biomass, demand control, energy efficient, energy generation, energy sources, fuel cell, geothermal, hydro, photovoltaics, clean energy certificates, solar, and wind. (Fig. 8_3 – hydrocarbons; page 3, paragraph 43 – see chart, categories separated into tier 1, tier 2, and tier 3; first tier includes petroleum)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time why they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be

obvious because their ultimate goal is finding a laboratory to perform the requested task.

15.   **With respect to claim 9: (currently amended)** Spencer teaches the limitations cited in the above rejections.   Spencer fails however Vanderboom discloses said selected land first tier displays a second tier of <u>predefined</u> criteria data categories selected from the group consisting of agriculture, extractive industries, forest, horticulture, industrial, open space, parks, and residential. (page 3, paragraph 43 – see chart, categories separated into tier 1, tier 2, and tier 3; agriculture mentioned in one of the tiers)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time why they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be

obvious because their ultimate goal is finding a laboratory to perform the requested task.

16.   **With respect to claim 10: (currently amended)** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses said selected waste first tier displays a second tier of <u>predefined</u> criteria data categories selected from the group consisting of bio-solids, construction/ demolition, fly ash/normal waste, fly ash/special waste, hazardous/biological, hazardous/chemical treatment, hazardous/disposal, hazardous/physical treatment, hazardous/recycling/reuse, hazardous/storage, hazardous/transportation, medical/special wastes, solid/landfills, solid/non-organic, solid/organic, solid/precycle, solid/recycling, solid/reduction, solid/reuse, and solid/waste to energy. (page 3, paragraph 43 – see chart, categories separated into tier 1, tier 2, and tier 3; medical products mentioned in second tier)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time why they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to

select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

17.   **With respect to claim 11: (currently amended)** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses said selected water first tier displays a second tier of <u>predefined</u> criteria data categories selected from the group consisting of aquifer recharge, "grey" water reuse, ground, industrial re-use, irrigation, non-point treatment, point source treatment, potable, quality, real time monitoring, storm, surface, use reduction, waste (effluent), and wetlands. (fig. 8_6 – surface topography)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time why they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to

select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

18.   **With respect to claim 12: (currently amended)** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses said third tier of <u>predefined</u> criteria data categories is selected from the group consisting of building/design,   carbon   trading,   conservation,   consulting,   consumer   products, ecology/biology,   ecotourism,   education/training/outreach,   emergency   response, engineering, equipment sales/rental, financial services, food, geographic information systems (GIS), geology/geophysical, import/export, information systems, legal services, management systems, marketing/communications, natural resource management, packaging/storage, pollution prevention, process/prevention technologies, public health, public policy, remediation, resource recovery, reuse, safety, source reduction, sustainable development, and transportation. (page 4, paragraph 61 -   consulting services provided)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time why they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer

with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

19.   **With respect to claim 13:** Spencer teaches the limitations cited in the above rejections.   Spencer fails however Vanderboom discloses criteria data categories selected from the group consisting of user identified environmental projects funding and cost data. (page 2, paragraph 72; Figs. 3_{10} and 3_{18} - "How is Pricing Established?" section – Labseek program contains project fee and cost of job defined in project.)

        As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific categories and cost information because this information would enable laboratories to know ahead of time whether they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer

system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

20.   **With respect to claim 14:** Spencer teaches the limitations cited in the above rejections.   Spencer fails however Vanderboom discloses criteria data categories selected from the group consisting of earliest begin date for said user identified environmental project, latest initiation date for said user identified environmental project, duration of said user identified environmental project, and location of said user identified environmental project. (fig. 3_3 – details include project description and work start date)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding start time of the project as well as location information because this enables laboratories to figure out if the can fit the project into their schedule. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides

the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories.   Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

21.   **With respect to claim 15:** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses said environmental project surveys further comprises: criteria data categories selected from the group consisting of partner type, target audience, community served, amount of resources required, quantifiable metrics/dollars spent, scalability of the user identified environmental projects, and replicability of said user identified environmental projects. (figs. 9_1 and 9_2 – general member information questions presented as well as services and scientist inventory)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time whether they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and

manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories.   Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

22.   **With respect to claim 16:** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses partner type is selected from the group consisting of business, government, non-government, and academic. (pages 3 and 4, paragraphs 57-61 – members can be corporate, non-profits or consultants)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time whether they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage

system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories.   Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

23.   **With respect to claim 17:** Spencer teaches criteria data categories selected from the group consisting of user biographical data and free form text. (col. 14, line 10-16 – general information on company such as)

24.   **With respect to claim 18: (currently amended)** Spencer teaches reporting means for generating a report from said user selected <u>predefined</u> criteria data category, said report selected from the group consisting of the number of user identified projects submitted, the past funds granted to a user, the past funds granted to a user identified project associated with said partner, and the comments on finished user identified environmental projects for a user. (col. 9, line 30-45 – up-to-date report on all information gathered with proposal)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system

Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

25.   **With respect to claim 19:** Spencer teaches a report selected from the group consisting of the number of user identified projects submitted within a date range, the number of user identified projects submitted by location, the number of user identified projects matching a specified duration, the number of user identified projects submitted by a specified user, the number of user identified projects that are scaleable, and the number of user identified projects that are replicable, the amount of funds being requested (average), the amount of administration costs being requested (average), the amount of leverage [cash, in-kind, both] (average), the number of projects (or % of projects) per category, the number of projects (or % projects) per target audience, (sorted by location), the number of projects (or % of projects) per partner type (average), and the amount of time to initiate a project (average), the estimated duration of a project (average). (Spencer: col. 9, line 30-45 – up-to-date report on all information gathered with proposal)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the

request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

Furthermore, the data identifying the types of environmental report is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships

between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the selectable options and the information displayed upon selection of each option adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the selectable options and the information displayed upon selection of the options does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

26.   **With respect to claim 20:** Spencer teaches the group consisting of world wide web, internet, intranet, and telephony. (col. 5, lines 60-63; col. 6, lines 15-30 – Internet-based computer system used)

27.   **With respect to claim 21: (Canceled)**

28.   **With respect to claim 22:** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses number assigning means for

assigning an identification number to each of said project surveys. (3₃ – project given

PO number)

As a result, it would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the teaching of Spencer with details of Vanderboom

regarding the specific projects because this would enable laboratories to know ahead of

time whether they should submit a proposal. As a result, it would have been obvious to

one of ordinary skill in the art at the time of the invention to modify the system in

Spencer with the Vanderboom invention in regards to finding a laboratory capable of

performing the request in the proposal. The Spencer system is web based and

manages the requests for proposals and responses. The Spencer system provides the

structure necessary to create the RFP, analyze responses and find an appropriate

match. The system Vanderboom presents an online laboratory services brokerage

system used to select laboratories capable of working on specific projects the match

their capabilities using a tier system for organizing categories.   Both disclosures

compliment each other because both deal with proposals and therefore the combination

of both would be obvious because their ultimate goal is finding a laboratory to perform

the requested task.

29.   **With respect to claim 23: (currently amended)** Spencer teaches an error

checking means for validating said <u>predefined</u> criteria data category selected on said

project survey prior to transmission to said central station. (col. 9, lines 1-12 –

responses are edited)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

30.   **With respect to claim 24:** Spencer teaches a receipt confirmation means for notifying said user that said project survey was received by said central station. (col. 8, lines 43-51 – email notification sent)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system

Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

31.   **With respect to claim 25:** Spencer teaches receipt confirmation means comprises email notification. (col. 8, lines 43-51 - email notification sent)

32.   **With respect to claim 26:** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses said receipt confirmation means includes said identification number. (Figure 3_{13} – project number used to identify project status)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the specific projects because this would enable laboratories to know ahead of time whether they should submit a proposal. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match

their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

33.   **With respect to claim 27: (currently amended)** Spencer teaches an updating means for allowing a user to update said <u>modified</u> project survey once it has been transmitted to said central station. (col. 16, lines 52-67 – database updated to reflect new changes.)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

34.   **With respect to claim 28: (currently amended)** Spencer teaches a locking means for disabling a user's ability to update said <u>modified</u> project survey once said

user identified project is under review by said central station. (col. 11, lines 20-26 – users have access only to data that they were given permission to view)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

35.   **With respect to claim 29:** Spencer teaches code search means for enabling said central station to search for the appropriate code listings that are used to dynamically populate list boxes on said project surveys. (col. 8, lines 23-38; col. 9, lines 60-64 – questions are compiled using question database)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the

request in the proposal. The Spencer system is web based and manages the requests

for proposals and responses. The Spencer system provides the structure necessary to

create the RFP, analyze responses and find an appropriate match. The system

Vanderboom presents an online laboratory services brokerage system used to select

laboratories capable of working on specific projects the match their capabilities using a

tier system for organizing categories. Both disclosures compliment each other because

both deal with proposals and therefore the combination of both would be obvious

because their ultimate goal is finding a laboratory to perform the requested task.

36.   **With respect to claim 30:** Spencer teaches the code listings is selected from the

group consisting of project categories, target audience type, organization type, partner

types, applicant type, state codes, and tiers. (col. 1, lines 52-60 – "The RFP's typically

comprised of questions related to the potential vendor's capabilities, operations,

financial history, service areas and more")

37.   **With respect to claim 31:** Spencer teaches editing means for allowing an user

to perform a function on the code listings selected from the group consisting of browse,

add, and delete. (col. 8, lines 43-51 – responses are edited)

38.   **With respect to claim 32: (currently amended)** Spencer teaches the limitations

cited in the above rejections. Spencer fails however Vanderboom discloses an archive

means for saving said <u>modified</u> environmental project survey to an archive library.

(Figure 5, item 7 – analysis report is archived)

        As a result, it would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the teaching of Spencer with details of Vanderboom

regarding the archiving of the report because this information would enable laboratories to have access to the information when the process is over. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

39.   **With respect to claim 33: (currently amended)** Spencer teaches a delete means for deleting said <u>modified</u> project survey from said database means once said <u>modified</u> environmental project survey has been archived to said archive library. (col. 16, lines 52-67 – responses can be deleted)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests

for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

40.   **With respect to claim 34: (currently amended)** Spencer teaches the limitations cited in the above rejections. Spencer fails however Vanderboom discloses an archive update means that notifies said users that said <u>modified</u> environmental project surveys will be sent to said archive library on said database means if not updated. (fig. 5, items 7 and 8 – lab has ability to archive reports)

As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Spencer with details of Vanderboom regarding the archiving of the report because this information would enable laboratories to have access to the information when the process is over. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage

system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

41.   **With respect to claim 35: (currently amended)** Spencer teaches a restore means for restoring said deleted <u>modified</u> project survey from said archive library to said database means. (col. 16, lines 58-59 – "retired response may be re-activated from retired status")

      Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

42.   **With respect to claim 36: (currently amended)** Spencer teaches the limitations

cited in the above rejections.   Spencer fails however Vanderboom discloses dating

means for tracking submitted dates and updated dates of said <u>modified</u> environmental

project surveys. (Vanderboom; Figure 3_{13} – column for "Date of RFP submission by

customer")

        As a result, it would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the teaching of Spencer with details of Vanderboom

regarding tracking submitted dates because this information would enable laboratories

and reviewers to know the status of proposal or whether it should be reviewed. As a

result, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system in Spencer with the Vanderboom invention in regards to

finding a laboratory capable of performing the request in the proposal. The Spencer

system is web based and manages the requests for proposals and responses. The

Spencer system provides the structure necessary to create the RFP, analyze responses

and find an appropriate match. The system Vanderboom presents an online laboratory

services brokerage system used to select laboratories capable of working on specific

projects the match their capabilities using a tier system for organizing categories. Both

disclosures compliment each other because both deal with proposals and therefore the

combination of both would be obvious because their ultimate goal is finding a laboratory

to perform the requested task.

43.   **With respect to claim 37: (currently amended)** Spencer teaches:

- presenting said user an project survey to a display connected to said remote computer, said project survey including at least one <u>predefined</u> criteria data category; (col. 6, lines 31-45 — applications can be completed over the Internet via remote computer.)

- transmitting said <u>modified</u> project survey to said <u>central station</u>; (col. 3, lines 18-25 - computer used to organize and make information accessible; web based interface used to make information accessible over the Internet)

- storing said <u>modified</u> project survey <u>in a</u> database, <u>which is</u> connected to said <u>central station</u>; (col. 4, lines 27-30; col. 8, lines 38-43 - RFP questions are stored in the response database) and

- automatically matching said <u>modified</u> project survey with said data representative of said resource provider <u>to identify</u> one of said environmental projects for funding by at least one of said resource providers. (col. 14, lines 56-67 — "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question")

- <u>translating said data which is input to said predefined data categories by said user to create a modified project survey;</u> (Spencer: Fig. 23 — survey with qualifying questions; col. 8, lines 20-55 — RFP questionnaire compiled from previous questions and previous RFPs)

Spencer does not teach the following limitation, however Vanderboom teaches environmental data and the following:

- inputting data, <u>which is received from said user</u> to said at least one <u>predefined</u> criteria data category on said environmental project survey, said environmental project survey having hierarchically organized tiers of <u>predefined</u> criteria data categories selected from the group consisting of air, energy, land, waste, and water, such that when one of the <u>predefined</u> criteria data categories are selected by said user, subcategories relating to said selected criteria data categories are displayed to said user; (page 3, paragraph 43 – see chart, categories separated into tier 1, tier 2, and tier 3; agriculture mentioned in one of the tiers)

     As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

     Furthermore, the data identifying purpose of the resource provider is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying purpose of the resource provider adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or

impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the selectable options and the information displayed upon selection of the options does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

44.   **With respect to claim 38: (currently amended)** Spencer teaches notifying said resource provider of said matching at least one criteria from said stored <u>modified</u> project surveys. (col. 4, lines 56-58 – "The RFP respondents may also be notified of their status on any given RFP.")

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

45.   **With respect to claim 39: (currently amended)** Spencer teaches saving said matching modified project survey in said database. (col. 14, lines 56-67 – "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question")

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

46.   **With respect to claim 40: (currently amended)** Spencer teaches:

- presenting an project survey to a user located at said remote computer, said project survey including at least one predefined criteria data category; (col. 6, lines 31-45 – applications can be completed over the Internet via remote computer.)

- transmitting said <u>modified</u> project survey to said central station including a database; (col. 3, lines 18-25 - computer used to organize and make information accessible)

- storing said <u>modified</u> project survey to said database (col. 4, lines 27-30; col. 8, lines 38-43 - RFP questions are stored in the response database);

- matching said inputted at least one <u>predefined</u> criteria data category from said project survey with said specific criteria to produce at least one <u>modified</u> project survey that matches said <u>predefined</u> criteria data category for selecting one of said environmental projects for funding by at least one of said resource providers; (col. 14, lines 56-67 – "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question") and

- transmitting from said central station to said resource provider said matched at least one <u>modified</u> project surveys. (col. 14, lines 56-67 – "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question")

Spencer does not teach the following limitation, however Vanderboom teaches environmental data and the following:

- inputting data, <u>received from said user,</u> into said at least one <u>predefined</u> criteria data category on said environmental project survey <u>to create a modified environmental project survey</u>, said environmental project survey having hierarchically organized tiers of <u>predefined</u> criteria data categories

selected from the group consisting of air, energy, land, waste, and water,

such that when one of the criteria data categories are selected by said user,

subcategories relating to said selected <u>predefined</u> criteria data categories are

displayed to said user; (page 3, paragraph 43 – see chart, categories

separated into tier 1, tier 2, and tier 3; agriculture mentioned in one of the

tiers)

As a result, it would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the system in Spencer with the Vanderboom invention in

regards to finding a laboratory capable of performing the request in the proposal. The

Spencer system is web based and manages the requests for proposals and responses.

The Spencer system provides the structure necessary to create the RFP, analyze

responses and find an appropriate match. The system Vanderboom presents an online

laboratory services brokerage system used to select laboratories capable of working on

specific projects the match their capabilities using a tier system for organizing

categories. Both disclosures compliment each other because both deal with proposals

and therefore the combination of both would be obvious because their ultimate goal is

finding a laboratory to perform the requested task.

Please note discussion of non-functional data in claim 37.

47.   **With respect to claim 41: (currently amended)** Spencer teaches saving to said

database said matching at least one <u>predefined</u> criteria data category from said

<u>modified</u> project survey. (col. 14, lines 56-67 – "preferably there are three outcomes, no

response matches the question, one response matches the question, or multiple
responses match the question")

Spencer does not teach environmental data, however the Vanderboom reference
teaches use of environmental data. As a result, it would have been obvious to one of
ordinary skill in the art at the time of the invention to modify the system in Spencer with
the Vanderboom invention in regards to finding a laboratory capable of performing the
request in the proposal. The Spencer system is web based and manages the requests
for proposals and responses. The Spencer system provides the structure necessary to
create the RFP, analyze responses and find an appropriate match. The system
Vanderboom presents an online laboratory services brokerage system used to select
laboratories capable of working on specific projects the match their capabilities using a
tier system for organizing categories. Both disclosures compliment each other because
both deal with proposals and therefore the combination of both would be obvious
because their ultimate goal is finding a laboratory to perform the requested task.

48.   **With respect to claim 42: (currently amended)** Spencer teaches:

- presenting a user <u>with a display of a user selected</u> project survey, said <u>user
  selected</u> project survey including at least one criteria data category; (col. 6,
  lines 31-45 – applications can be completed over the Internet via remote
  computer.)

- <u>translating input received from said user to said predefined data categories to
  create a modified project survey;</u>

- selecting said at least one <u>modified</u> criteria data category on said <u>modified</u> project survey; (col. 6, lines 31-45 – applications can be completed over the Internet via remote computer.) and

- transmitting said <u>modified</u> project survey to a central station. (col. 8, lines 39-51 – document posted in Internet)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

49.   **With respect to claim 43: (currently amended)** Spencer teaches editing said transmitted <u>modified</u> project survey after it is stored at said central station. (col. 9, lines 1-7, responses can be edited and modified)

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of

ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

50.   **With respect to claim 44: (currently amended)** Spencer teaches:

- selecting said at least one <u>predefined</u> criteria data category to <u>of said user</u> <u>identified project</u> query with said input device; (col. 6, lines 37-45 – user selects search criteria)

- matching at least one of said <u>predefined</u> criteria data category with at least one of said specific criteria <u>of said at least one resource provider</u>; (col. 14, lines 56-67 – "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question")

- generating, responsive to said <u>step of matching a</u> report <u>which identifies the</u> <u>match of said predefined criteria data category of said user identified project</u>

with said at least one of said specific criteria of said at least one resource
provider; and displaying the results of said report to said display. (col. 9, lines
30-45 – proposal analysis are presented in user customized reports)

Spencer does not teach environmental data, however the Vanderboom reference
teaches use of environmental data. As a result, it would have been obvious to one of
ordinary skill in the art at the time of the invention to modify the system in Spencer with
the Vanderboom invention in regards to finding a laboratory capable of performing the
request in the proposal. The Spencer system is web based and manages the requests
for proposals and responses. The Spencer system provides the structure necessary to
create the RFP, analyze responses and find an appropriate match. The system
Vanderboom presents an online laboratory services brokerage system used to select
laboratories capable of working on specific projects the match their capabilities using a
tier system for organizing categories. Both disclosures compliment each other because
both deal with proposals and therefore the combination of both would be obvious
because their ultimate goal is finding a laboratory to perform the requested task.

51.   **With respect to claim 45: (currently amended)** Spencer teaches:

- providing at least one server computer located at a central station in
  communication with a computer network; (col. 6, lines 31-45 – applications
  can be completed over the Internet via remote computer.)

- generating at least one project survey from said server computer; (col. 8, lines
  23-38 – question database used to create questions for RFP)

- transmitting said at least one project survey from said server computer to at least one remote computer; (col. 6, lines 31-45 – applications can be completed over the Internet via remote computer.)

- inputting data received from a user to at least one of said predefined criteria data category on said at least one project survey to create a modified project survey; (col. 8, lines 23-38 – question database used to create questions for RFP)

- transmitting said modified project survey to said at least one server computer; (col. 3, lines 18-25 - computer used to organize and make information accessible)

- storing data representative of said at least one resource provider at said central station; (col. 4, lines 27-30; col. 8, lines 38-43 - RFP questions are stored in the response database) and

- matching said at least one predefined criteria data category from said at least one project survey with data representative of said at least one resource provider. (col. 14, lines 56-67 – "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question")

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the

request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

52.   **With respect to claim 46: (currently amended)** Spencer teaches a match among the stored at least one said <u>predefined</u> criteria data category from said at least one <u>modified</u> project survey and said <u>data representative of</u> at least one said resource provider. (col. 14, lines 56-67 – "preferably there are three outcomes, no response matches the question, one response matches the question, or multiple responses match the question")

Spencer does not teach environmental data, however the Vanderboom reference teaches use of environmental data. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Spencer with the Vanderboom invention in regards to finding a laboratory capable of performing the request in the proposal. The Spencer system is web based and manages the requests for proposals and responses. The Spencer system provides the structure necessary to create the RFP, analyze responses and find an appropriate match. The system Vanderboom presents an online laboratory services brokerage system used to select

laboratories capable of working on specific projects the match their capabilities using a tier system for organizing categories. Both disclosures compliment each other because both deal with proposals and therefore the combination of both would be obvious because their ultimate goal is finding a laboratory to perform the requested task.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Heidi Riviere/
Examiner, Art Unit 3689